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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/236,339	01/25/1999	SEIICHI KASHIWABA	865.4327	1626

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NEW YORK, NY 10112

EXAMINER

NGUYEN, THONG Q

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 06/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicant(s)

09/236,339

Applicant(s)

KASHIWABA ET AL.

Examiner

Thong Q. Nguyen

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 April 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 6-11 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-11 and 19-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Response to Amendment***

1. The present Office action is made in response to the Amendment (Paper No. 23) filed on 04/11/2002.

### ***Drawings***

2. The objection to the drawings under 37 CFR 1.83(a) as set forth in the previous Office action (Paper No. 22) of 1/11/02, page 2 is repeated. In particular, the drawings fail to show the feature concerning the arrangement of the deformation restricting member between the coupling members and the first holding member as recited in each of claims 1, 11, and 19-22.

*Applicant's arguments as provided in the Amendment (Paper No. 24, pages 11-12) have been fully considered but they are not persuasive. It is also noted that the examiner has carefully review the specification and the drawing, in particular, in figure 4, but has not found any description to support for the feature claimed. Applicant should note that the feature thereof "a deformation...being varied" (claim 1, lines 15-18) is understood as there is not any element in the space between the coupling members and the first holding member. Applicant should note that figure 4 shows the deformation restricting member (119) disposed between the coupling members (145) and the second holding member (118) while the first holding member (109) is located apart from the coupling members. Applicant is respectfully invited to review the specification in pages 23+. While applicant has admitted that the second holding member is located between the coupling members (145) and the first holding member (109); however,*

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1<sup>b</sup> 2<sup>c</sup>

Art Unit: 2872

*applicant has failed to provide or show the arrangement of the elements disclosed in the specification and the figure 4 match with the arrangement of the system as shown in the figure 4.*

**Claim Rejections - 35 USC § 112**

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-3, <sup>6-9, 11</sup> ~~6-11~~, and <sup>19-20</sup> 19-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 1 is rejected under 35 USC 112, second paragraph for the following reasons: 1) the claim is indefinite because it is unclear about the arrangement of the elements as recited in the feature thereof "a first holding...second holding member" (lines 3-20). In other words, it is unclear about the position of the deformation restricting member with respect to the first and second holding members as recited in the mentioned feature. Applicant should note that the specification in page 23+ and in figure 4, for example, show that the deformation restricting member (119) is located between the coupling members (145) and the second holding member (118). The figure 4 does not show that the deformation restricting member (119) is located between the coupling members (145) and the first holding member (109) as claimed. Applicant should note that the feature thereof "a deformation...first holding member" (claim 1, lines 15-16) is understood as there is not any element in the space between the coupling

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Art Unit: 2872

members and the first holding member; and 2) the claim is indefinite because it is unclear about the structure of the first holding member, the second holding member and the coupling members so that the positions of the first and second holding members are able to vary in a vertical direction during the process of coupling by the coupling members.

b) Claim 11 is rejected under 35 USC 112, second paragraph for both reasons as set forth in element a) above.

c) Each of claims 19-22 is rejected for the reason 1) as set forth in element a) above.

d) Claim 9/7/1 is confusing. The claim recites a friction preventing member located between the coupling members and the second holding member (see claim 7, lines 2-3), and claim 9 recites that the mentioned friction preventing member serves as the deformation restricting member (see claim 9, lines 2-3).

As such, it is unclear how many member(s) located between the coupling members (145) and the second holding member (118). If there is only one member located between the coupling members (145) and the second holding member (118) so why applicant has recited the mentioned member is located between the coupling members and the first holding member in claim 1. If there is more than one member between the coupling members and the second holding member then the claim is rejected under 35 USC 112, first paragraph because the specification does not disclose the use of a deformation restricting

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Art Unit: 2872

member and a friction preventing member in the same location as recited in claim 9/7/1.

e) The remaining claims are dependent upon the rejected base claim and thus inherit the deficiencies thereof.

### ***Double Patenting***

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claim 21 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 19. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

It is noted that the differences between claim 21 and 19 is the positive recitation of the optical axes of the first and second optical elements and the coupling of the first and second holding members at a position within a range of relative movement between two holding members (see claim 21, lines 2-8); however, such features are readable from the feature "a first holding...being coupled" (claim 19, lines 2-13), in particular, in the language thereof "permit relative

positions of said ...being coupled" (claim 19, lines 5-7) and "said plurality...optical element" (claim 19, lines 10-13).

7. Claim 22 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 20. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

See the same reason as set forth in element 6) above.

*It is noted that while applicant has made an amendment to claim 9; however, applicant has not made any amendments to claims 21 and 22 as well as provided any arguments to overcome the objections of claims 21 and 22 under 37 CFR 1.75.*

### ***Claim Rejections - 35 USC § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1-3, 6-9, 11, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Sezerman (U.S. Patent No. 4,889,406) in view of Kohno (U.S. Patent No. 5,652,922) (both of record).

Sezerman discloses an optical system having a first fiber (12), a second fiber (14) and a coupling apparatus for coupling the two mentioned fibers. The coupling system comprises a first base plate (18) supporting the first fiber (14), a second base (16) supporting a second fiber; a plurality of coupling elements (34,

34a), and an deformable annular ring (32). The system when completely being assembled has the deformable annular ring located between the two base plates, and each of the coupling member will go through the holes formed on each of the plates and the ring. Each of the base plates comprises a bore for supporting the fiber so that the optical axes of the fibers will be kept in alignment to each other. The operation on the coupling members will permit a relative movement of the base plates with respect to each other in a vertical direction. In other words, one skilled in the art will recognize that the process of assembling the system will require a first step of adjusting the base plates in a vertical direction for the purpose of making an initial alignment between the fibers and the holes formed on the plates before the coupling members are used for coupling the plates. The only feature missing from the optical system provided by Sezerman is that he does not disclose the use of urging members between the coupling members and the second base plate as claimed. However, the use of urging members in the form of a deformable washers with the coupling members in the form of screws for coupling two elements is clearly suggested to one skilled in the art as can be seen in the optical system provided by Kohno. For instance, at column 7 and in figure 10A, the coupling system comprises a plurality of screws (25) and deformable washers (22) wherein the coupling system is used to couple the first element (7) to the second element (21). It is noted that the use of a press plate between the screws and the first holding member is also suggested by Kohno when he teach the use of the press plate (24) between the screws (25) and the



Art Unit: 2872

holding member (7). Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the optical system provided by Sezerman by using urging members in the form of deformable washers as suggested by Kohno for the purpose of preventing the damage to the holding member during the time of coupling the holding members together.

10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sezerman in view of Kohn as applied to claim 7 above, and further in view of Hasegawa (U.S. Patent No. 4,780,640, of record).

See the reasons as set forth in the previous Office action (Paper No. 22, pages 9-10).

#### ***Response to Arguments***

11. Applicant's arguments filed on 4/11/2002 have been fully considered but they are not persuasive.

First, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Second, applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or

Art Unit: 2872

objections. In particular, applicant has argued that the combined product provided by Sezerman and Kohno discloses a deformable angular ring, but it does not disclose a deformable restricting member as that of the inventive device. The Examiner respectfully disagrees with the applicant's viewpoint and respectfully invited the applicant to review the present application and the art of Sezerman. The use of the ring, i.e., ring 32, in the device of Sezerman and the use of the ring (119) in the present application are so similarly. Both are located between two elements which are affected by the force of screws. The material of the ring 32 is a resilient material which is deformable as that of the material used in the ring (119) of the present application. See Sezerman, columns 5-6. Further, the present claims fail to recite any specific limitations of the ring (119) to make it different or distinguish from that of prior art.

Third, with regard to applicant's arguments concerning the art of Hasegawa, the Examiner respectfully disagrees with the applicant's opinion because all of the features concerning the restricting member are disclosed by the primary reference, i.e., the art of Sezerman. The art of Hasegawa is used as a secondary reference in the combination provided by Sezerman and Kohno for the purpose of showing one skilled in the art the interchangeability of an element in a set of elements. Applicant is respectfully invited to review the rejection made in the previous Office action, and is repeated in this Office action.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 2872

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

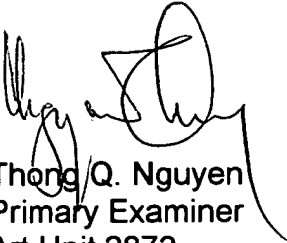
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is 703 308 4814. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on 703 308 1687. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308 7724 for regular communications and 703 308 7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.

Application/Control Number: 09/236,339  
Art Unit: 2872

Page 11



Thong Q. Nguyen  
Primary Examiner  
Art Unit 2872

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June 26, 2002